

REMARKS

This Amendment and Response is filed in reply to the Office Action dated August 12, 2003. In this Response, Applicants amend independent claims 1, 17, 25, 27, 43, 51, and 53, and traverse the Examiner's rejection of Applicants' independent claims. Support for the amendments can be found throughout the originally filed disclosure and particularly in pages 36-45. Amendments to the claims are not an acquiescence to any of the rejections. Furthermore, silence with regard to any of the Examiner's rejections is not an acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicants consider allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claim(s), but rather a recognition by Applicants that such previously lodged rejection is moot based on Applicants' remarks and/or amendments relative to the independent claim (that Applicants consider allowable) from which the dependent claim(s) depends. Furthermore, any amendments to the claims are being made solely to expedite prosecution of the instant application. Applicants reserve the option to further prosecute the same or similar claims in the instant or a subsequent application. Upon entry of the Amendment, claims 1-2, 4-28, 30-49, and 51-54 are pending in the present application.

The issues of the August 12, 2003 Office Action are presented below with reference to the Office Action.

With regard to the Office Action Summary: Applicants note that the "application/control number", shown incorrectly as 09/560,005, should be 09/560,006.

With regard to the disposition of Applicants' claims, independent claims 27 and 43 were *not* canceled in any communication to the United States Patent and Trademark Office. Moreover, on page 2 of the Office Action, the Examiner correctly states that claims 27 and 43, among other claims, are elected for examination. Accordingly, Applicants consider independent claims 27 and 43 to remain pending in the instant application.

With regard to the Office Action, paragraphs 1-2: The Examiner correctly states that claims 1-2, 4-8, 30-49, and 51-54 are elected for examination.

With regard to the Office Action, paragraph 3: Applicant thanks the Examiner for the acknowledgement of the claim of priority.

With regard to the Office Action, paragraph 4: Claims 5, 8, 28, 30-42, and 44-49 were objected to because of informalities. Applicants have amended claims 5, 8, and 31 as suggested by the Examiner. Furthermore, claims 28, 30-42, and 44-49 were alleged to depend upon cancelled claims. Claims 28 and 30-42 depend upon independent claim 27, and claims 44-49 depend upon independent claim 43. Independent claims 27 and 43 are pending in the instant application, and thus, claims 28, 30-42, and 44-49 do not require correction as noted by the Examiner. Applicants thus traverse the Examiner's objection to claims 5, 8, 28, 30-42, and 44-49.

With regard to the Office Action, paragraph 5: Claims 1-2, 4-26, 28, 30-42, 44-49, and 51-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Contois (U.S. Patent No. 5,864,868) in view of Arons et al. (U.S. Patent No. 6,529,920). Applicants amend independent claims 1, 17, 25, 27, 43, 51, and 53, and traverse the rejection of the independent claims.

As Examiner knows, and based at least on MPEP 2143, a prima facie case of obviousness under 35 U.S.C. 103(a) requires (1) a suggestion or motivation in the references themselves or generally known in the art, to combine the references, (2) a reasonable expectation of success to combine, and (3) a teaching, via the combination, of all the claimed limitations. *In re Vaeck*, 947 F. 2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claims 1, 25, 27, 51, and 53, directed to a method and a product for selecting a multimedia presentation, have been amended to recite, among other things, providing a plurality of multimedia presentations; providing one or more multimedia data items, each of said one or more multimedia data items being a *duplicate of a portion* of a corresponding one of said plurality of multimedia presentations; and presenting said one or more multimedia data items using a browser. Support for the amendments can be found in the application on pages 42-45. Specifically, the application provides that "multimedia data which may be extracted and used as an index ... includes any one of a variety of multimedia types." (Application, p.42 lines 3-5)

Further, “image-based indices are generated in accordance with the indexing media. ... if other types of indices besides those which are image-based are used, these are also generated.”

(Application, p.44, lines 12-14) Applicants thus amend the aforementioned independent claims to more clearly state the inherent features of the originally filed claims with respect to the multimedia data items, where such claims are amended to more clearly state that the multimedia data items are *a duplicate of a portion of a corresponding multimedia presentation*.

Nowhere does Contois teach multimedia data items that are a *duplicate* of a portion of a multimedia presentation, as claimed in Applicants’ independent claims 1, 25, 27, 51, and 53. In contrast to Applicants’ claims Contois teaches a system and method for controlling a media playing device in which a user interacts with data fields displayed on a computer screen to choose music or video selections from a media database, where media playback buttons on the computer screen allow the user to control playback of music or video selections (Contois, col. 9 line 21 - col. 11 line 29; FIGs. 2-6). As shown in FIGs. 2-6 of Contois, titles of selected songs are listed in the “SELECTED SONGS” data field. Regarding FIG. 6, Contois teaches that in the graphics window above the playback buttons, once a song title is selected to be played, the graphics window will display a picture of something associated with the selected piece of music (Contois, col. 12 lines 13-21). The titles of selected songs listed in the “SELECTED SONGS” data field are descriptive *pointers* to the music media and, unlike Applicants’ claimed multimedia data items, are not a *duplicate* of a portion of the media. Furthermore, the graphics window (Contois, FIG. 6) displays a picture of something associated with a selected piece of music and is also not a *duplicate* of a portion of a multimedia presentation.

Accordingly, Contois does not teach the feature of independent claims 1, 25, 27, 51, and 53 directed to multimedia data items that are a duplicate of a portion of a multimedia presentation. Furthermore, modifying Contois with Arons et al. to include the feature of controlling the speed of playback, as suggested by the Examiner, still does not provide multimedia data items that are *a duplicate of a portion of a multimedia presentation*, as claimed by Applicants. Accordingly, the Examiner fails to establish a prima facie case of obviousness since the proposed combination of Contois and Arons et al. does not teach every feature of Applicants independent claims 1, 25, 27, 51, and 53. Applicants thus traverse the rejection of independent claims 1, 25, 27, 51, and 53.

Applicants' failure to address other requirements for prima facie obviousness should not be construed as an acquiescence to such other requirements, but rather, a recognition by Applicants that the satisfaction or non-satisfaction of such elements is moot based on the failure of the proposed combination to show all elements of Applicants' claims.

Applicants thus consider independent claims 1, 25, 27, 51, and 53 to be allowable. Claims 2 and 4-16 depend upon allowable independent claim 1, claim 26 depends upon allowable independent claims 25, claims 28 and 30-42 depend upon allowable independent claim 27, claim 52 depends upon allowable independent claim 51, and claim 54 depends upon allowable independent claim 53. Dependent claims 2, 4-16, 26, 28, 30-42, 52, and 54 are thus also allowable for depending upon an allowable base claim.

Independent claims 17 and 43, directed to method or product for selecting a multimedia presentation, have been amended to recite, among other things, providing a multimedia presentation, and providing one or more multimedia data items associated with said multimedia presentation, a first of said one or more multimedia data items being a *duplicate of a portion* of said first media stream and corresponding to a portion of said second media stream. Applicants traverse the rejection of independent claims 17 and 43 for at least the same reasons provided relative to allowable independent claims 1, 25, 27, 51, and 53. In particular, the proposed combination of Contois and Arons et al. does not teach the feature of Applicants' independent claims 17 and 43 directed to multimedia data items that are *a duplicate of a portion of a first multimedia stream*. Accordingly, the Examiner fails to establish a prima facie case of obviousness for independent claims 17 and 43. Applicants thus traverse the Examiner's rejection of independent claims 17 and 43.

Applicants thus consider independent claims 17 and 43 to be allowable. Claims 17-24 depend upon allowable independent claim 17, and claims 44-49 depend upon allowable independent claims 43. Dependent claims 17-24 and 44-49 are thus also allowable for depending upon an allowable base claim.

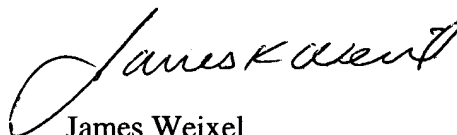
Title

Applicants amend the title in accordance with the preamble of the independent claims. No new matter is presented.

Conclusion

Applicants consider the Response herein to be fully responsive to the referenced Office Action. Based on the above Remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicants' attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at (781) 466-2220.

Respectfully submitted,



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